

PATENT APPLICATION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Esswein et al.

Group: 1626

Serial No. 09/675,943, filed September 29, 2000

Examiner: L. Stockton

For: OSTEOBLAST-SPECIFIC MITOGENS AND DRUGS CONTAINING SUCH
COMPOUNDS

COMMUNICATION

Nutley, New Jersey 07110
September 13, 2001

Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

This Communication is filed in response to the August 16, 2001 Office Action issued in connection with the above-identified patent application. A response to this Office Action is due September 15, 2001.



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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/675,943	
	Filing Date	September 29, 2000	
	First Named Inventor	Angelika Esswein	
	Group Art Unit	1626	
	Examiner Name	L. Stockton	
Total Number of Pages in This Submission		Confirmation Number	

ENCLOSURES (check all that apply)		
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Remarks <div></div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	John P. Parise
Signature	
Date	September 13, 2001

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail on the date shown below in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231:			
Typed or printed name	John P. Parise		
Signature		Date	September 13, 2001

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In the Office Action restriction was required under 35 U.S.C. § 121. Specifically, there are allegedly two independent and distinct groups of inventions. Group I includes claims 7 and 21-23, wherein X is oxygen. Group II includes claims 7, 23 and 24 wherein X is an H.

In response to this restriction requirement, applicants elect, with traverse, to prosecute at this time the invention of Group II, claims 7, 23 and 24, wherein X is NH. Applicants traverse this restriction since it would not be a serious burden on the Examiner to search all of the claims at this time.

Applicants were required under 35 U.S.C. § 121 to elect a single disclosed species for searching purposes. Applicants traverse the election requirement because the Patent Office is required as a matter of law to examine on the merits the entirety of the generic claims (see below).

Procedures for making an election of species are described in MPEP 809.02 and 37 C.F.R. §1.146. Under 37 C.F.R. §1.146, the Patent Office may "require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted **if no claim to the genus is found allowable**" (emphasis added). Once a generic claim is found to be allowable in substance, even though it is objected to or rejected on merely formal grounds, action on the species claims shall thereupon be given as if the generic claim were allowed. MPEP 809.02(e). Therefore, the Patent Office should not have required election under 35 U.S.C. § 121 until a determination of patentability was made with respect to the generic claims.

Whether the claimed species are patentably distinct is irrelevant to the determination of patentability of applicants' claims directed to the elected species and the generic claims that read on these species. Unless all generic claims have been rejected, no question of patentability arises with regard to the non-elected species. In view of the limited number of species claimed in the present application, examination of each and every species on the merits should follow allowance of the generic claims.

In re Wolfrum and Gold, 179 USPQ 620, 622 (CCPA 1973) addresses the examination of claims in the context of rejection made under 35 U.S.C. § 112, "the scope of the subject matter is governed not by the examiner's conception of the 'invention' but by that 'which the applicant regards as his invention'.... applicant is free under that provision to set the metes and bounds of 'his invention' as he sees them..... Thus a determination by the Patent Office that earlier, separate claims encompass a 'plurality of different inventions' cannot serve, *under* § 112, as the basis for a rejection of a later combined claim....the rationale of the rejection also encompasses the provisions and mandate of 35 U.S.C. 101 and 121 (emphasis in original text)."

Applicants are entitled to a complete action on the merits of all claims, including those readable on the elected species, i.e. claims 7 and 23. Failure of the Patent Office to consider such claims in their entirety would be tantamount to a rejection and appealable. *In re Hass*, 179 USPQ 623, 627 (CCPA 1973) the court stated that "An examiner's adverse action of this nature *is* a rejection, a denial of substantive rights. Review thereof must fall within the jurisdiction of the board" (emphasis in original text).

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It is well-established law that restriction within a single claim cannot be sustained under 35 U.S.C. §121. As is stated in *In re Weber*, 198 USPQ 328 (CCPA 1978) at pages 331-332,

"§121 provides the Commissioner with the authority to promulgate rules designed to *restrict an application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It is not, however, provide a basis for the Examiner acting under the authority of the Commissioner to *reject* a particular *claim* on that same basis." (Emphasis in original text).

Applicants have the right to claim their invention as they deem appropriate, as long as the requirements of 35 U.S.C. §112 are met. See *In re Weber* at 331 and *In re Wolfrum and Gold* at 622.

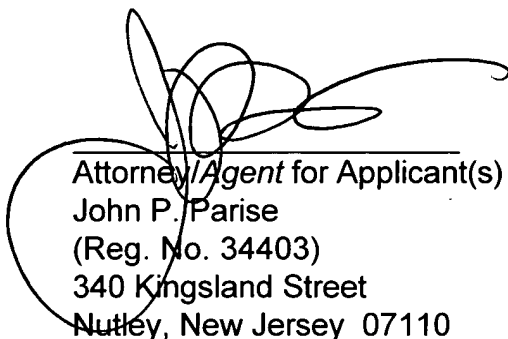
→ The above being stated, applicants select the species *cis*-9-octadecenoic acid-2-hydroxy-3-phosphonoxypropylamide. This compound is described on page 22 of the specification in Example 2.

If a telephone conference would be of assistance in furthering prosecution, applicants request that the undersigned attorney be contacted at the number below.

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No fee is required in connection with the filing of this Communication. If any fees are deemed necessary, authorization is given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,



Attorney/Agent for Applicant(s)
John P. Parise
(Reg. No. 34403)
340 Kingsland Street
Nutley, New Jersey 07110
Telephone: (973) 235-6326
Telefax: (973) 235-2363

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